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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/638,164	08/14/2000	Shunsuke Furukawa	7217-62363	1043

7590 11/09/2005
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EXAMINER

DAVIS, ZACHARY A

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 11/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/638,164	Applicant(s) FURUKAWA ET AL.	
	Examiner Zachary A. Davis	Art Unit 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, 9, 10, 13-15, 17, 35, 37-39, 42-45, 48, 49 and 52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10, 13-15, 17, 35, 37-39, 42-45, 48, 49 and 52 is/are allowed.
- 6) ☒ Claim(s) 1-4, 6 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20050912</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A Request for Continued Examination was received on 22 August 2005. The amendment after Final action, received on 15 July 2005, has been entered and considered. Claims 1, 10, 13-15, 35, 38, and 45 have been amended. Claims 8, 12, 16, 18, 22, 23, 25, 27, 28, 30-33, 36, 41, 47, 53, 56-58, 60, and 61 have been canceled. No new claims have been added. Claims 1-4, 6, 9, 10, 13-15, 17, 35, 37-39, 42-45, 48, 49, and 52 are currently pending in the present application. Claims 49 and 52 were allowed in the Office action of 26 April 2005.

Response to Amendment

2. The rejection of Claims 1-4, 6, and 9 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement and the objection to the specification for failing to provide proper antecedent basis for the claims is withdrawn in light of the amendments to the claims. However, the indication of allowable subject matter in Claims 1-4, 6, and 9 is withdrawn due to the change in scope resulting from the amendments to the claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Tosaki et al, US Patent 6590846.

In reference to Claim 1, Tosaki discloses a data storing medium including a digital data area (column 5, line 67-column 6, line 1); a control data area (the second control data area of column 6, lines 16-19); and a plurality of copyright control information areas (the first control data area of column 6, lines 10-14) in which the same copyright control information is written, where the copyright control information areas are spaced apart by a predetermined interval (column 8, lines 1-3; Figure 2, elements 3 and 14, noting that the embossed elements are spaced apart at intervals, further noting that all of the embossed elements are part of the first control data area containing copyright control data). Tosaki further discloses that the copyright control information areas are embossed to be write-prohibited (the first control data area can be embossed, column 6, lines 14-16) and the control data area is write-permitted (the second control data area can be recorded, column 6, lines 19-24).

In reference to Claim 2, Tosaki further discloses that a sector containing the control data area is write-permitted (column 6, lines 19-24).

In reference to Claim 3, Tosaki further discloses that a sector containing the copyright control information is write-prohibited (column 6, lines 14-16).

In reference to Claim 4, Tosaki further discloses that the storing medium is a recordable medium (the DVD-R of column 7, lines 54-55).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tosaki in view of Matsumoto et al, US Patent 6320829.

Tosaki discloses everything as applied to Claim 1 above. However, Tosaki does not disclose that data is recorded that is different from the copyright control information that is not detected as an error by error correction code. Further, Tosaki does disclose that the data is modulated (Figure 3, modulation circuit 13), but does not disclose the specific modulation method as 8-16 modulation.

Specifically in reference to Claim 6, Matsumoto discloses a copy control system including recording data different from copyright control information that is not detected

as an error by error correction code (the main data is encoded with error correction code which is generally not detected as an error, column 8, lines 30-37).

Specifically in reference to Claim 9, Matsumoto discloses that data is modulated by 8-16 modulation (Figure 2, 8-16 modulator 16; column 8, lines 47-51).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the medium of Tosaki to include 8-16 modulation and to record data not detected as an error, in order to prevent unauthorized copying of digital data more effectively by allowing the use of different forms and levels of copy restriction (see Matsumoto, column 2, lines 25-27).

Allowable Subject Matter

7. Claims 10, 13-15, 17, 35, 37-39, 42-45, and 48 are allowed.
8. Claims 10, 35, 38, and 45 have been amended to incorporate the subject matter of Claims 16 (and 12), 36, 41, and 47 that was indicated as allowable in the Office action of 26 April 2005, and are therefore allowable for the reasons indicated therein.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachary A. Davis whose telephone number is (571) 272-

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3870. The examiner can normally be reached on weekdays 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Matthew D. Smithers
MATTHEW SMITHERS
PRIMARY EXAMINER
Art Unit 2137